UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *18 July 2008*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1- 11* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-11* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *04 January 2006* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *6/16/08,3/29/07, 1/4/06*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Priority

1.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which

papers have been placed of record in the file.

Information Disclosure Statement

2.   The information disclosure statement (IDS) submitted on 6/16/08, 3/29/07, 1/4/06

the information disclosure statement is being considered by the examiner.

Drawings

3.   The Examiner has approved drawings filed on 1/4/06.

Claim Objections

4.   Claim 1 is objected to because of the following informalities:

In claim 1, line 1, change [1] , to -- 1 -- .

In claim 2, line 1, change [2] , to -- 2 -- .

Similarly all the claims need to be corrected .

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter as follows. Claim 11 defines "A program" for

making a computer function as a pen embodying functional descriptive material.

However, the claim does not define a computer-readable medium or memory and is

thus non-statutory for that reason (i.e., "When functional descriptive material is recorded

on some computer-readable medium it becomes structurally and functionally

interrelated to the medium and will be statutory in most cases since use of technology

permits the function of the descriptive material to be realized" – Guidelines Annex IV).

That is, the scope of the presently claimed can range from paper on which the program

is written, to a program simply contemplated and memorized by a person. The

examiner suggests amending the claim to embody the program on "computer-readable

medium" or equivalent in order to make the claim statutory. Any amendment to the

claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
>
> claiming the subject matter, which the applicant regards as his invention.

Claims 1 and 9 are rejected under 35 U.S.C. 112, second paragraph, the phrase

"or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not

actually disclosed (those encompassed by "or the like"), thereby rendering the scope of

the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the
>
> United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in

the United States before the invention by the applicant for patent, except that an international application filed under the treaty

defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the

international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 - 11 are rejected under 35 U.S.C. 102(e) as being anticipated by

Furukawa et al., (US. 20040085301 A1, Listed in IDS filed 3/29/07).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome

either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the

invention "by another," or by an appropriate showing under 37 CFR 1.131.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) do not apply to the examination of this application as the application

being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35

U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

As to claim 1, Furukawa discloses an editing system configured to include a

paper which is prepared to specify an entry location and on which paper space

information including a figure, a character, and the like is printed, a digital pen for

acquiring information entered by handwriting as stroke data, and a pen server for

executing an editing process of the paper space information on the basis of the stroke

data acquired by the digital pen, the editing system characterized in that (paragraph

0061,explains acquisition and storing the editing stroke of digital pen):

the pen server is configured to include (fig 3 and 4):

a command database for inclusively storing command execution information for indicating a content of the editing process that the pen server is caused to execute to have correspondence to one or more command for specifying an editing process of the paper space information (paragraph 0061,explains acquisition and storing the editing stroke of digital pen):

a paper space information database for storing the paper space information that corresponds to locations on the paper (paragraph 0073 explains paper space information is explained);

a character recognizing portion that recognizes a character from the stroke data and converts the recognized character into a character code (paragraph 0078 and 0079);

a paper space information cutout portion that recognizes a line from the stroke data and extracts the paper space information included in a target region specified by the recognized line from the paper space information database (note, paragraph 0073, fig 2A and 2B, shows the relationship of paper and digital pen, also see paragraph 0079 and fig 5);

a command recognizing portion that detects the command stored in the command database from the character code outputted by the character recognizing portion (paragraph 0078, the pen stroker data received from the data input terminal, also see paragraph 0079 and fig 6); and

a command executing portion that executes the editing process on the basis of

the command execution information corresponding to the command detected by the

command recognizing portion (paragraph 0081,0082 and 0083 explain the editing

commands (symbols).

As to claim 2, Furukawa discloses the editing system as claimed in claim 1

characterized in that the paper space information cutout portion recognizes the

character or a mark, written in the vicinity of the target region and relates it as a symbol

for identification to the extracted paper space information (fig 15A and 15 B explains the

editing process with regards to editing location on paper, stroke details etc).

As to claim 3, Furukawa discloses the editing system as claimed in claim 2

characterized in that in the command database are stored to have correspondence to a

predetermined command:

parameter definition information for defining that a parameter added to the

command is the symbol; and command execution information for outputting as an

electronic file the paper space information, extracted by the paper space information

cutout portion, related to the parameter (fig 15A,15B and paragraph 0080 explains the

use of parameter information which is contained in a table format).

As to claim 4, Furukawa discloses the editing system as claimed in claim 2

characterized in that in the command database is stored command execution

information for converting, at the character recognizing portion, the stroke data entered

on the paper with the digital pen into a character code outputted as an electronic file (fig

5, explains the processing of character code recognition from the stroke data extend the

digital pen and a paper, see paragraph 0078).

As to claim 5, Furukawa discloses the editing system as claimed in claim 4

characterized in that in the command database is further stored correspondingly to a

predetermined second command:

parameter definition information for defining that a parameter added to the

second command is the symbol (paragraph 0080 explains paper space information is

the information constituting the stroke position information of a stroke on the paper as

symbol storage, control symbol storage and operations example could be instruction,

also see paragraph 0082); and

command execution information for causing insertion of the paper space

information, related with the parameter, extracted by the paper space information cutout

portion, at an entry location of the second command of the electronic file on the

assumption that it is entered after entry of the first command (paragraph 0080 explains

paper space information is the information constituting the stroke position information of

a stroke on the paper as symbol storage, control symbol storage and operations

example could be instruction) .

As to claim 6, Furukawa discloses the editing system as claimed in claim 2

characterized in that the pen server is configured to further include a classified

information database for storing a subclass title corresponding to a subclass used in

International Patent Classification and a subgroup title corresponding to a subgroup, in

the command database are stored to have correspondence to a predetermined

command:

parameter definition information for defining that a first parameter added to the

command is the symbol, a second parameter is the subclass, and a third parameter is

the subgroup (note, editing system explained in paragraph 0080 the editing system

function is described to include all the elements, parameter definition, data base

classification into tables, parameter definition (symbols), see also fig 5 and 15A and

15B); and

command execution information for searching the classified information database

for the subclass title corresponding to the second parameter, and the subgroup title

corresponding to the third parameter to output an electronic file, and adding link

information directed to the electronic file to the paper space information related with the

first parameter (note, editing system explained in paragraph 0080 the editing system

function is described to include all the elements, parameter definition, data base

classification into tables, parameter definition (symbols), see also fig 5 and 15A and

15B).

As to claim 7, Furukawa discloses the editing system as claimed in claim 2

characterized in that in the command database are stored to have correspondence to a

predetermined command: parameter definition information for defining that the

parameter added to the command is the symbol (note, paragraph 0082, the control

symbols and corresponding operations are stored (fig 7) deletion control example given

in (fig 7, item 701 and 702 and other function are shown in (fig 7, item 703 – 706); and

command execution information for converting at the character recognizing portion the

stroke data entered with the digital pen in the target region recognized by the

paper space information cutout portion, related with the parameter, into a character

code and adds it to the paper space information of the paper(note, paragraph 0082, the

control symbols and corresponding operations are stored (fig 7) deletion control

example given in (fig 7, item 701 and 702 and other function are shown in (fig 7, item

703 – 706).

As to claim 8, Furukawa discloses the editing system as claimed in any one of

claim 1 or 7 characterized in that the paper on which the paper space information is

printed is configured to include:

a specifying region for specifying a region for editing the paper space information

with the digital pen (note fig 3 and 4 describe the steps in recognizing and editing paper

space information provided by digital pen see fig 3 (item 301), also see the paragraph

0078) ; and

a command entry region for entering a command with the digital pen (note fig 3 and 4

describe the steps in recognizing and editing paper space information provided by

digital pen see fig 3 (item 301), also see the paragraph 0078).

Regarding claim 9, it is interpreted and thus rejected for the same reasons as

applied above in the rejection of claim 1.

As to claim 10, Furukawa discloses the editing method as claimed in claim 9

characterized in that the paper on which the paper space information is printed is

configured to include:

a specifying region for specifying a region for editing the paper space information with the digital pen (note, fig 4 explains the editing process using digital pen for example of delete, add, replace, emphasize etc are shown specifying a region on the paper with the digital pen , also see paragraph 0071); and

a command entry region for entering a command with the digital pen (note, fig 4 explains the editing process using digital pen for example of delete, add, replace, emphasize etc are shown specifying a region on the paper with the digital pen, also see paragraph 0071).

As to claim 11, Furukawa discloses a program for making a computer function as a pen server as claimed in any one of claims 1 to 7 (note, paragraph 0071 it is explicitly implied that a program is present to communicate with a computer from the electronic pen, see also fig 13 , item 1301).

Other prior art cited

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Manly (US. 3,676,856) discloses automatic editing system and method.

Sklarew (US. 6,212,297 B1) discloses handwritten keyboardless entry computer system.

Sklarew (US. 5,365,598) discloses a handwritten keyboardless entry computer system.

Hawkins et al., (US. 6,493,464 B1) discloses multiple pen stroke character set and handwriting recognition system with immediate response .

Kong (US. 7,119,794 B2) discloses character and text unit input correction system .

Komatsu (US. 6,999,622 B2) discloses stroke data editing device .

Contact Information

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEELA C. CHAWAN whose telephone number is (571)272-7446. The examiner can normally be reached on 7.30- 5.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Werner can be reached on 571-272-7401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sheela C Chawan/

1/30/09

Primary Examiner, Art Unit 2624